

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Suk H. Cho
Serial No. : 10/765,654
Filed : January 27, 2004
Title : DIETARY SUPPLEMENTS AND METHODS FOR TREATING PAIN AND INFLAMMATION

Art Unit : 1655
Examiner : Michele Flood
Conf. No. : 1195

MAIL STOP ISSUE FEE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL LETTER

The following correspondence relating to this application is enclosed.

- 1) Completed PTOL-85 Form (1 page)
- 2) Response to Notice of Allowance (1 page)
- 3) Comments on Examiner's Reasons for Allowance (3 pages)
- 4) Check in the amount of \$1700 for Issue Fee and Publication Fee payment.

Please apply any charges not covered, or any credits, to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 10/2/06

Teresa A. Lavoie, Ph.D.
Reg. No. 42,782

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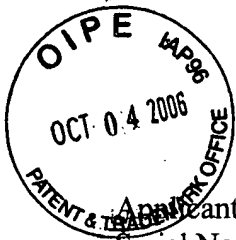
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I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

10/2/2006
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MEREDITH MESCHER
Typed or Printed Name of Person Signing Certificate



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Title : DIETARY SUPPLEMENTS AND METHODS FOR TREATING PAIN AND
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Alexandria, VA 22313-1450

RESPONSE TO NOTICE OF ALLOWANCE

In response to the Notice of Allowance mailed August 31, 2006, enclosed are a completed issue fee transmittal form PTOL-85b and a check for \$1700 for the required issue fee and publication fee. Also enclosed are comments on the Examiner's reasons for allowance.

Please apply any additional charges or credits to our Deposit Account No. 06-1050.

Respectfully submitted,

Date: 10/2/06

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COMMENTS ON EXAMINER'S REASONS FOR ALLOWANCE

In response to the Notice of Allowability dated July 25, 2006, the Notice of Allowance dated August 31, 2006, and the Examiner's Interview Summary dated July 11, 2006, Applicant respectfully submits the following remarks. With respect to the Interview Summary dated July 11, 2006, the Examiner stated that Applicant indicated it would be difficult to "rebut the Examiner's basis for establishing a *prima facie* case of obviousness, which relied on interviews with the inventor of a *prior art* composition found on the world wide web and invoices dated prior to the filing of Applicant's application, or to establish the veracity of the contents of the invoices (emphasis added)." As stated more fully in the Response to Office Action dated February 2, 2006, the compositions described in the world wide web pages are, in fact, *not* "prior art" compositions, as the web pages were not "printed publications" available more than 1 year prior to the filing date of the present patent application. Moreover, the Examiner's *sua sponte*-initiated telephonic interviews with two third party manufacturers of nutritional supplements were also insufficient to meet the on-sale bar or public use requirements of 35 U.S.C. § 102(b), as MPEP § 706.02(c) states that "an applicant may make an admission, or submit evidence of sale of the invention or knowledge of the invention by others, or the examiner may have

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personal knowledge that the invention was sold by applicant or known by others in this country (emphasis added).” Applicant has at no point made any admission regarding sale or knowledge of the invention by others. In addition, at no point did the Examiner state that she had “personal knowledge” that the claimed invention was sold or known by others. The uncorroborated interviews did not constitute “personal knowledge” of the Examiner regarding prior sale or use of the claimed invention.

With respect to the Examiner's Reasons for Allowance, Applicant disagrees with the Examiner's statement that the “closest art prior to the invention” is taught at the previously described web pages. Applicant again reiterates that the web pages referred to by the Examiner are not “prior art,” for the reasons set forth above and in the Response dated February 2, 2006. In addition, Applicants note that the Guberman invoice relied upon by the Examiner merely sets forth a date for sale prior to the present application's priority date for a composition known as the “Ultimate Joint Repair Formula.” The invoice is *silent* as to the types or percentages of ingredients provided in such a composition and thus provides *no information* as to the content of the composition. Applicant agrees with the Examiner that the Office, therefore, *could not* “ascertain the date of making of the referenced (invoice) product” or the “date when the referenced (invoice) product was first made available for public sale in the United States comprising ingredients which appear to be the same or essentially the same as those contained in the composition disclosed by Applicant.” Applicant thus *strongly disagrees* with the Examiner's statements that “it appears that the aforementioned (Guberman) prior art composition is *the same or essentially the same* as that disclosed by Applicant” . . . “and it appears that the referenced product is used in a method of treatment that is the *same or essentially the same* as that disclosed by the Applicant (emphasis added).” In sum, Applicant reiterates that the web pages are not prior art to the presently claimed methods; the interviews with third party nutritional supplement manufacturers are not prior art to the presently claimed methods; and the Guberman invoice does not establish that a composition sold thereunder was prior art to the presently claimed methods. Accordingly, Applicant agrees with the Examiner's statement that the “Office cannot rely upon the cited references and thereby properly establish a proper *prima facie* case of obviousness.”

Applicant recognizes that in accordance with M.P.E.P. § 1302.14, the Examiner's reasons for allowance need not set forth all of the details as to why the claims are allowed. In the above-referenced application, Applicant does not concede that the Examiner's stated reasons for

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Attorney's Docket No.: 09143-018002

allowance are the only reasons for which the claims are allowable. Furthermore, Applicants assert that the claims may be patentable for other reasons..

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Respectfully submitted,

Date: 10/2/00



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